

REMARKS

In response to the Office action mailed March 27, 2002, Applicants elect with traverse Group IV, drawn to method for diagnosing colorectal cancer. In particular, Applicants traverse the restriction between groups IV and XIII. The claims of Group XIII are drawn to methods of determining prognosis of colorectal cancer. ✓

Where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions (MPEP §803.01). In establishing that an "undue burden" exists for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching difficulties, the Examiner must show that the restricted groups have a separate classification, acquired a separate status in the art, or that searching would require different fields of search (MPEP §808.02). Applicants respectfully submit that the inventions of the present application can readily be searched without undue burden.

Applicants request that the Examiner join Groups IV and XIII since a search for one of the groups will identify art pertaining to the other.

In order to claim the subject matter of the invention more specifically, claims 1-31 have been canceled and claims 32-47 have been added. Claims 32-43 are drawn to methods of diagnosing breast cancer or colorectal cancer and claims 44-47 are drawn to methods of determining the prognosis of breast cancer or colorectal cancer. No new matter is added. The newly added claims find support in the originally filed claims and in the specification.

Support for claims 32-43 is found in original claim 7 and in the specification on page 6, lines 19-26, and page 7, lines 26-31. Support can also be found on page 13, lines 23-34, page 16, lines 15-17, and page 22, lines 17-29. Claims 44-47 find support in original claim 31 and in the specification on page 6, lines 19-26, and page 7, lines 26-30. Support can also be found on page 13, lines 23-34 page 16, lines 15-17, and page 22, lines 17-29.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,



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